



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,950	07/23/2001	Shripad S. Bhagwat	10624-047-999	3712

20583 7590 12/27/2002

PENNIE AND EDMONDS
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 100362711

EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT	PAPER NUMBER
----------	--------------

1626

DATE MAILED: 12/27/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
--------------------	-------------	-----------------------	------------------

EXAMINER

ART UNIT	PAPER NUMBER
----------	--------------

DATE MAILED:

10

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on October 3, 2002

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~thirty days~~, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 5, 6, 10-20, 22-69 and 71-117 are pending in the application.
Of the above, claim(s) 22-69, 75-84, 86 and 87 are withdrawn from consideration.
- ☒ Claim(s) 117 is/are allowed.
- ☒ Claim(s) 5, 6, 10-20, 71-74, 85 and 88-116 are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Serial Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-15?

~SEE OFFICE ACTION ON THE FOLLOWING PAGES~

09/910,950

DETAILED ACTION

Claims 5, 6, 10-20, 22-69 and 71-117 are pending in the application.

Election/Restrictions

Applicants' election of Group I in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The requirement is still deemed proper and is therefore made FINAL.

Claims 22-69, 75-84, 86 and 87 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions.

Rejections made in the previous Office Action which do not appear below have been overcome by the amendment to the claims or cancellation of claims. Therefore, arguments pertaining to these rejections will not be addressed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 6, 10-20, 71-74, 85 and 88-116 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The variable “a”, and its definition, is not needed in claims 5 and 6. The variable R_4 , and its definition, is not needed in claims 10-13 and 71-74. The variable “d”, and its definition, is not needed in claims 10-20, 71-74 and 85.

Each of the following claims have a minimum of one compound listed that is not embraced by the claims they depend. In claim 107, the first compound is not embraced by claim 10. In claim 108, the 4th compound in the claim is not embraced by claim 11. In claim 109, the next to the last compound listed in the claim is not embraced by claim 12. In claim 111, the 3rd compound listed in the claim is not embraced by claim 14. In claim 114, the 3rd compound from the bottom on page 114 is not embraced by claim 18. In claim 115, the 15th compound listed on page 118 is not embraced by claim 19. Applicants are encouraged to review species in every species claim to verify antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 13 is rejected under 35 U.S.C. 102(a) as being anticipated
by Carter et al. {GB 2,345,486}.

Carter et al. disclose a product that is embraced by instant claim

13. See the compound named on page 139, lines 10-11 or CA Registry
No. 307328-34-3.

Claims 10 and 14 are rejected under 35 U.S.C. 102(b) as being
anticipated by:

a) Andronati et al. {CA 122:314528, 1995} – see, for example,
5-chloro-3-phenyl-1H-indazole (CA Registry No. 13097-03-5);

- b) Buck et al. {CA 120:299030, 1994} – see, for example, 3-(6,7-dimethoxy-1-isoquinolinyl)-1H-indazol-5-ol (CA Registry No. 154458-84-1);
- c) Grayshan et al. {CA 112:216936, 1990} – see 5-chloro-3-(4-pyridinyl)-1H-indazole (CA Registry No. 126971-86-6);
- d) Fujimura et al. {CA 107:198159, 1987} – see, for example, 3-phenyl-1H-indazole-5-carbonitrile (CA Registry No. 83684-54-2);
- e) Jones et al. {CA 100:51503, 1984} – see 5-fluoro-3-phenyl-1H-indazole (CA Registry No. 57614-63-8);
- f) Pfoertner et al. {CA 97:72295, 1982} – see, for example, 5-bromo-3-(2-pyridinyl)-1H-indazole (CA Registry No. 82616-92-0);
- g) Fujimura et al. {CA 84:31053, 1976} – see, for example, 5-bromo-3-phenyl-1H-indazole (CA Registry No. 57639-16-4);
- h) Walser et al. {CA 83:164108, 1975} – see 2-(5-chloro-1H-indazol-3-yl)phenol (CA Registry No. 55076-04-5); and
- i) Horner et al. {CA 70:77962, 1969} – see, for example, 5-methoxy-3-phenyl-1H-indazole (CA Registry No. 13097-05-7).

Each of the above cited references disclose products embraced by the instant claims.

Claims 5, 13-17, 88 and 93-97 are rejected under 35 U.S.C. 102(e) as being anticipated by Reich et al. {U.S. 2002/0161022}.

Reich et al. disclose products that are embraced by the instant claims, which are useful in diseases/disorders such as cancer, rheumatoid arthritis, etc. See, for example, compound 1 on page 19, second column; compound 3 on page 22, first column; etc.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 13-20, 71-74, 85, 88, 94-105 and 111-116 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reich et al. {U.S. 2002/0161022}.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicants claim indazole products. Reich et al. teach indazole products which are either structurally the same as the instant claimed products (see above 102 rejections) or structurally similar to the instant claimed products, which are useful in treating, for example, rheumatoid arthritis.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between some of the products of the prior art and the products instantly claimed is that of generic description.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

The indiscriminate selection of “some” among “many” is *prima facie* obvious. The motivation to make the claimed compounds derives from

the expectation that structurally similar compounds would possess similar activity (e.g. treating rheumatoid arthritis).

One skilled in the art would thus be motivated to prepare products embraced by the prior art to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful in treating, for example, rheumatoid arthritis. Therefore, the instant claimed products would have been suggested to one skilled in the art.

Response to Arguments

Applicants' arguments filed October 3, 2002 have been fully considered. Applicants argue that the compounds in Carter et al. {GB 2,345,486} lack an $-A-R_1$ group and therefore are not within the scope of amended claim 13. In response, Carter et al. anticipate instant amended claim 13. See in instant claim 13 wherein A is $-CH_2-$, R_1 is an aryl substituted with R_3 , R_3 is halogen, R_2 is $-CH_2-NR_5R_6$, R_5 is hydrogen and

R_6 is a substituted heterocycle substituted with R_3 wherein R_3 is a substituted heterocycle.

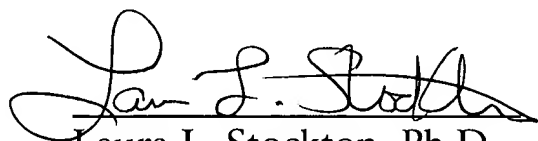
Allowable Subject Matter

Claim 117 is allowed over the art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

A handwritten signature in black ink, appearing to read "Laura L. Stockton", is written over a horizontal line.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

December 24, 2002